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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,694	12/13/2000	Rayi Ganesan	335036	6528

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EXAMINER

COLBERT, ELLA

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/734,694

Applicant(s)

GANESAN, RAYI

Examiner

Ella Colbert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-58 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-57 are pending. Claim 58 has been canceled/withdrawn in Response to the Election Restriction Requirement filed 01/13/05 entered as Response After Election/Restriction. Claims 1-57 were elected for prosecution without traverse.
2. The Election/ Restriction Requirement of 12/07/04 is hereby withdrawn after a careful review and consideration of the pending claims 1-58 in view of a new Election/Restriction Requirement as set forth here below.

### ***Election/Restrictions***

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-51, drawn to processing bill payment information, classified in class 705, subclass 43.
  - II. Claims 52-57, drawn to receiving an instruction to pay a bill of the payee, classified in class 705, subclass 40.
  - III. Claim 58, drawn to receiving from a person information identifying the person and a deposit account associated with the person, classified 705, subclass 14.
4. The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and Group II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed

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does not require the particulars of the subcombination as claimed. The combination claims 1, 18, and 35 are directed to a method, system, and article of manufacture for "processing bill payment information identifying a payee to whom the payer intends to electronically direct payment and transmitting a notice to the payer that the bills of the payee are available electronically. The subcombination has separate utility such as "notifying a payer of the availability of the electronic bill presentment, receiving from a payer an instruction to pay a bill of the payee, accessing a database with information identifying the payees offering of electronic bill presentment, and notifying the payer that the payee offers the electronic bill".

5. Group I, Group II, and Group III are related as combination and subcombination.

6. The inventions are distinct, each from the other because of the following reasons:

Inventions Group I, Group II, and Group III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed. The combination claims 1, 18, and 35 are directed to a method, system, and article of manufacture for "processing bill payment information identifying a payee to whom the payer intends to electronically direct payment and transmitting a notice to the payer that the bills of the payee are available electronically and Group II. The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and Group II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed. The combination claims 1, 18, and 35 are directed to a method, system, and article of manufacture for "processing bill payment information identifying a payee to whom the payer intends to electronically direct payment and transmitting a notice to the payer that the bills of the payee are available electronically" and Group II has "notifying a payer of the availability of the electronic bill presentment, receiving from a payer an instruction to pay a bill of the payee, accessing a database with information identifying the payees offering of electronic bill presentment, and notifying the payer that the payee offers the electronic bill". The subcombination Group III has separate utility such as "receiving from a person information identifying the person and a deposit account associated with the person, a first database and a second database for storing electronic billing information and information identifying unregistered persons, determining if the information stored in the second database identifies the new person, and notifying the person of the availability of the stored electronic billing information". The database of Group III can be used for storing the notice to the payer after it is transmitted and for retaining the information identifying a payee, and accessing the database with the information identifying the payee offering the electronic bill for presentment.

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7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
8. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II and the search for Group II is not required for Group I, restriction for examination purposes as indicated is proper.
9. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
10. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday, 6:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
E. Colbert  
March 28, 2005